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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>05 November 2008</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1,2,4,6-10 and 14-28</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1,2,4,6-10 and 14-28</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination ("RCE") under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application

is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR

1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn

pursuant to 37 CFR 1.114. Applicant's submission filed on 5 November 2008 has been entered.

Acknowledgements

2.   This action is responsive to the RCE filed 5 November 2008.

3.   In accordance with the RCE noted above, claims 1, 2, 4, 6-10, and 14-28 are pending and

have been examined.

4.   This action has been assigned paper number 20090108 for reference purposes only.

Specification

5.   The disclosure is objected to because of the following informalities: "URI," while being

a term of art, is never spelled out as to what it stands for. The Examiner requests that Applicants

clearly show that a "URI" is a "Uniform Resource Identifier" in their specification and/or claims

in order to remove any ambiguity that may exist.

6.   Appropriate correction is required.

Claim Objections

7.   Claim 2 is objected to because of the following informalities: The claim ends with a ":"

not a ".". Appropriate correction is required.

Claim Rejections - 35 USC § 112

8.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

9.   Claims 10, 17-23, and 26-28 rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

10.   Claims 10, 18-23, and 26-28 fail to set out the corresponding structures for means-plus-

function limitations as discussed below under "Claim Interpretations." For purposes of prior art,

these means limitations as set out above, have been interpreted under the broadest reasonable

interpretation as the corresponding structures required for interpretation under 35 U.S.C. 112 6th

paragraph could not be found.

11.   Regarding claims 17 and 23, the phrase "such that" renders the claim indefinite because it

is unclear whether the limitations following the phrase are part of the claimed invention. See

MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on
> sale in this country, more than one year prior to the date of application for patent in the United States.

12.   Claims 1, 2, 4, 6-10, and 14-28; as understood by the Examiner, are rejected under 35

U.S.C. 102(b) as being anticipated by Ginter (US 5,892,900).

13.   As to claim 1,Ginter shows:

A method of enabling a Digital Item **300** to be consumed or otherwise manipulated

according to a set of operations defined by the Digital Item author **102** or other entitled party

106, the method including the step of incorporating a Digital Item manipulation method **1000** or

methods defining said set of operations **808** into the Digital Item (Figure 5B).

14.   As to claim 2, Ginter shows:

       a.   A method of enabling a Digital Item **300** to be consumed or otherwise

       manipulated

       according to a set of operations defined by the Digital Item author **102** or other entitled

       party **106**, the method includes the following steps:

       b.   incorporating a Digital Item manipulation method **1000** or methods defining said

       set of operations **808** into a Digital Item (Figure 5B);

       c.   providing said Digital Item **300**, or a Digital Item declaration **802** to a device **600**;

       enabling said device to:

       d.   a. determine an appropriate Digital Item manipulation method or methods for the

       application (according to method requirements and administration, **808**, Figure 5B);

       e.   b. retrieve said appropriate Digital Item manipulation method or methods (Step

       110, Figure 2) ;

f.   c. interpret said set of operations from said appropriate digital item manipulation

method or methods (through Rights Operating System **602** in device **600**); and

g.   d. perform interpreted set of operations from said digital item manipulation

method or methods on said digital item (C 13, LL 27-49).

15.   As to claims 4 and 10, Ginter shows:

h.   A method of enabling a Digital Item **300** to be consumed or otherwise

manipulated according to a set of operations defined by the Digital Item author **102** or

other entitled party **106**, the method includes the following steps:

i.   incorporating a Digital Item manipulation method or methods **1000** into a Digital

Item defining said set of operations (Figure 5B);

j.   providing said Digital Item **300**, or a Digital Item declaration **802** to a device **600**;

k.   enabling said device to:

l.   determine an appropriate Digital Item manipulation method or methods for the

application (according to method requirements and administration, **808**, Figure 5B);

m.   retrieve said appropriate Digital Item manipulation method or methods (Step 110,

Figure 2);

n.   configure said appropriate Digital Item manipulation method or methods for said

Digital

Item (modify, Figure 2A);

o.   interpret said set of operations from said appropriate Digital Item manipulation

method or methods (through Rights Operating System **602** in device **600**); and

     p.   perform said interpreted set of operations from said Digital Item manipulation method or methods on said Digital Item (C 13, LL 27-49).

16.   As to claim 6, Ginter further shows:

     q.   the Digital Item manipulation method is provided within the Digital Item or the Digital Item declaration (Figure 5B).

17.   As to claims 7 and 28, Ginter further shows:

     r.   receiving predetermined information including at least one of information regarding user preferences, device capabilities and consumption environment ("payment operating environment") , and utilizing the predetermined information, in part, to configure the appropriate Digital Item manipulation method ("created, modified, and/or reused" to fit the environment, CC 8-9, LL 50-2).

18.   As to claims 8, 18, and 19; Ginter further shows:

     s.   the Digital Item manipulation method includes an Intellectual Property Management and Protection (IPMP) mechanism (C 43, LL 22-42).

19.   As to claim 9, Ginter further shows:

20.   protecting said device using said IPMP mechanism (C 49, LL 14-30).

21.   As to claims 14 and 20, Ginter further shows:

t.   said set of operations is described in a script (C 252, LL 41-57).

22.   As to claims 15 and 21, Ginter further shows:

u.   said script **806** is included in the Digital Item 300 as a resource within the Digital

Item accessed by a reference URI from the Digital Item declaration (declaration is

interpreted as the parts of the container **300** that are not the content **304**.) (Figure 17).

23.   As to claims 16 and 22, Ginter further shows:

v.   said script **808** is provided within the Digital Item declaration itself as a descriptor

810 (Figure 17).

24.   As to claims 17 and 23, Ginter further shows:

w.   said script is referenced by an identifier such that a device, or a family of devices

might have the operations of said script inbuilt at manufacturer or by later modification

(As part of the rights OS **602**).

25.   As to claims 24 and 26, Ginter further shows:

x.   determining whether the device can perform the Digital Item manipulation

method (C 248, LL 18-34).

26.   As to claims 25 and 27, Ginter further shows:

y.   identifying elements of the Digital Item which can be processed by the Digital

Item manipulation method (Step 3350, Figure 67B).

Claim Interpretations

27.   There is a three pronged test to see if a limitation invokes 35 U.S.C. 112 6th

paragraph set out in MPEP 2181(C):

A claim limitation will be presumed to invoke 35 U.S.C. 112, sixth paragraph, if it meets

the following 3-prong analysis:

(A)   the claim limitations must use the phrase "means for " or "step for; "

(B)   the "means for " or "step for " must be modified by functional language; and

(C)   the phrase "means for " or "step for " must not be modified by sufficient

structure, material, or acts for achieving the specified function.

28.   For the following limitations, the Examiner has concluded that each of the three prongs

above has been satisfied:

29.   <u>Means Limitations (ML's)</u>

    1)   "means for incorporating a Digital Item Manipulation method or methods defining

            said set of operations into a Digital Item" in claim 10;

    2)   "means for providing said Digital Item, or a Digital Item declaration to a device" in

            claim 10;

    3)   "means for determining an appropriate Digital Item manipulation method or methods

            for the application" in claim 10;

    4)   "means for retrieving said appropriate Digital Item manipulation method or methods"

            in claim 10;

    5)   "means for interpreting said set of operations from said appropriate Digital Item

            manipulation method or methods" in claim 10;

    6)   "means for performing said interpreted set of operations from said Digital Item

            manipulation method or methods" in claim 10;

    7)   "means for protecting said device using said IPMP mechanism" in claim 19;

    8)   "means for determining whether the device can perform the Digital Item

            manipulation method" in claim 25; and

    9)   "means for identifying elements of the Digital Item which can be processed by the

            Digital Item manipulation method" in claim 27;

30.   Each of the above listed means limitations (1-9), meets prong (A) as they all expressly

recite the phrase "means for." Conversely, any limitation not found above does not meet prong

(A). For example, the limitation "means to receive predetermined information including at least

one of…" as recited in claim 28, as it recites "means to" and not the required "means for."

31.   Each of the above listed means limitations (1-9), meets prong (B) as the "means for" in

each case is modified by functional language as noted below:

32.   <u>Means Limitation</u>   <u>Functional Language</u>

   1)   "incorporating a Digital Item Manipulation method or methods defining said set of

          operations into a Digital Item;"

   2)   "providing said Digital Item, or a Digital Item declaration to a device;"

   3)   "determining an appropriate Digital Item manipulation method or methods for the

          application;"

   4)   "retrieving said appropriate Digital Item manipulation method or methods;"

   5)   "interpreting said set of operations from said appropriate Digital Item manipulation

          method or methods;"

   6)   "performing said interpreted set of operations from said Digital Item manipulation

          method or methods;"

   7)   "protecting said device using said IPMP mechanism;"

   8)   "determining whether the device can perform the Digital Item manipulation method;"

   9)   "identifying elements of the Digital Item which can be processed by the Digital Item

          manipulation method;"

33.   Finally, each of the above listed means limitations (1-9), meets prong (C) because the "means for" limitations are not modified by sufficient structure, material, or acts for achieving the specified function.

34.   A patent applicant who employs means-plus-function language must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112. To avoid purely functional claiming in cases involving computer-implemented inventions, we have consistently required that the structure disclosed in the specification be more than simply a general purpose computer or microprocessor. Because general purpose computers can be programmed to perform very different tasks in very different ways, simply disclosing a computer as the structure designated to perform a particular function does not limit the scope of the claim to 'the corresponding structure, material, or acts that perform the function, as required by section 112 paragraph 6. Thus, in a means-plus-function claim in which the disclosed structure is a computer, or microprocessor, programmed to carry out an algorithm, the disclosed structure is not the general purpose computer, but rather the special purpose computer programmed to perform the disclosed algorithm. Consequently, a means-plus-function claim element for which the only disclosed structure is a general purpose computer is invalid if the specification fails to disclose an algorithm for performing the claimed function.

35.   For each of the means limitations (1-9), the Examiner could not conclude what the specific structure is from Applicants' disclosure. Therefore, each claim containing at least one of

these means limitations is rejected under 35 U.S.C. 112 2nd paragraph as being indefinite for

failing to particularly point out and distinctly claim the invention.

36.   Should Applicants believe sufficient structure is disclosed and the structure is expressly

recited, Applicants should expressly state this on the record and provide appropriate evidence in

support thereof.

37.   Should Applicants believe sufficient structure is disclosed but the structure is not clearly

linked and associated, Applicants must amend their specification to clearly link and associate the

corresponding structure to the claimed function. See MPEP §2181's section discussing 37 C.F.R.

§ 1.175(d)(1). Otherwise, Applicants are advised to remove the means limitations from their

claims.

38.   As always, Applicants are reminded that any amendment to the specification and/or

claims must not constitute new matter.

Response to Arguments

39.   Applicant's arguments with respect to claims 1, 2, 4, 6-10, and 14-28 have been

considered but are moot in view of the new grounds of rejection.

Conclusion

40.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-

3270. The Examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.

41.   If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's

supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

42.   Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Joshua Murdough
Examiner, Art Unit 3621

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Supervisory Patent Examiner, Art Unit 3621